UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,242	12/09/2003	Brian Jones	60001.296US01	4899

27488	7590	09/05/2006

MERCHANT & GOULD (MICROSOFT)
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER
TSUI, WILSON W

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/731,242	JONES ET AL.
	Examiner	Art Unit	
	Wilson Tsui	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/8/2006*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-14 and 16-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-14 and 16-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20060608*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This application is in response to the amendment filed on: 6/8/2006, and

IDS filed on: 6/8/2006.

2.   In the amendments, claims 1, 6, 10, 16, 18, and 19 are amended and

claims 5 and 15 are cancelled. Claims 1-4, 6-14, and 16-22 remain pending in

the application. Claims 1, 10, and 18 are independent claims.

3.   The rejection under 35 U.S.C. 101 for claims 18-22, remain rejected for

reasons explained in the Response to Arguments section below.

4.   The rejections under 35 U.S.C. 102(b) for claims 1, 3, 5, 6, 7, and 8 has

been withdrawn as necessitated by the amendments. In addition, the rejections

of claims 2, 10, 12, 13, 15-21 under 35 U.S.C. 103(a), claim 4 under 35 U.S.C.

103(a), claim 9 under 35 U.S.C. 103(a), claims 11 and 22 under 35 U.S.C.

103(a), and claim 14 under 35 U.S.C. 103(a) have also been withdrawn as

necessitated by the amendments.

Information Disclosure Statement

5.   The information disclosure statement filed 06/12/2006 fails to comply with

the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the required list of

information set forth in 37 CFR 1.98(a) have not been satisfied. It has been

placed in the application file, but the information referred to therein has not been

considered as to the merits. Applicant is advised that the date of any re-

submission of any item of information contained in this information disclosure

statement or the submission of any missing element(s) will be the date of

submission for purposes of determining compliance with the requirements based

on the time of filing the statement, including all certification requirements for

statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one

skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention.

With regards to claim 1, the applicant claims "wherein the properties

comprise at least one of a context free chunk element and a table element". Yet,

the specification teaches determining whether the properties relating to a mini

document include determining the mini document corresponds to a chunk

element, or table element, as opposed to determining whether there are chunk

element or table element properties corresponding to the mini document. See

page 18, lines 18-30: whereas, the chunk element and table elements that were

introduced are only through *the result* of a mapping process, and not because

there were pre-existing chunk and table elements in the mini-document.

With regards to claim 10, and 18, they include substantially the same

limitations discussed in the amended claim 1, and are rejected under the same

rationale.

With regards to claims 2-4, 6-9, 11-14, 16, 17, and 19-22, they are rejected for at least the same reasons that the base claims on which they rely/depend upon, are rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 1, 6, 10, 16, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 1, the applicant claims "wherein the properties comprise at least one of a context free chunk element and a table element". Yet, the applicant also claims "mapping the properties of the mini document into a markup language element". It is unclear how the properties, which comprise at least one of a context free chunk element and a table element, be mapped to a markup language element, seeing that the properties are *already* markup language element(s) (chunk element, and/or table element, see page 18, lines 18-30 in the specification). Thus, mapping properties which are elements (based upon the claim language), to the same type of elements does not particular point out the subject matter which the applicant regards as the invention.

With regards to claims 10, and 18, they include substantially the same limitations discussed in the amended claim 1, and are rejected under the same rationale.

With regards to claims 6, 16, and 19, they are dependent claims including the same limitations as discussed in the amended claim 1, and are rejected under the same rationale.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 18-22 are rejected on the basis that the claimed "system" appears to be directed to a "computer program per se" without hardware. Since the computer program not embodied on a computer readable medium is non-statutory subject matter, see MPEP 2105 below:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material

Per Se or Computer Programs Representing Computer Listings *Per Se*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure

defines structural and functional interrelationships between the data structure

and the computer software and hardware components which permit the data

structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1, 3, 6-8 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Altamura et al (IJDAR, published: November 7, 2000, pages

6-12) in further view of Chakraborty (US Application: US 2004/0194035 A1, filed:

Mar. 31, 2003).

With regards to claim 1, Altamura et al teaches a method comprising:

- *Determining properties corresponding to a mini-document that relates to at least one section of an application document:* (Fig. 3, P6-5: whereas, layout analysis is performed to determine the properties for each block in a document (where each block relates to a segment of a document image, and thus represents a mini-document of the entire application document)).

- *Mapping the properties of the mini-document into a markup language element:* (P9-3: whereas, the properties of the mini-document, such as a

running-header, is mapped into an element (labeled 'ID'), and assigned an

ID value such as 'id0').

- *Storing the properties of the mini-document in the markup language*

  document. (P8-1 and P9-3: whereas, the properties are stored in a DTD

  data file).

However, Altamura et al does not expressly teach wherein the properties

comprise at least one of a table element.

Chakraborty teaches wherein *the properties comprise at least one of a table*

element (whereas, a document is analyzed to determine the properties of

different sections (paragraph 0017), which includes table element properties (Fig

2, paragraph 0034: whereas, each table box is a table element property, and

each of the table elements properties are further mapped into an appropriate

XML table element in an AIU/XML file (paragraph 0010)).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Altamura et al's methed for determining properties

corresponding to a mini-document, to have further included determining the

properties comprise at least one of a table element, as taught by Chakraborty.

The combination of Altamura et al and Chakraborty would have allowed Altamura

et al to have "automatically extracted form information (document structure,

elements, format, etc.) from electronic documents such as raster-based passive

documents and storing such form information in a file in accordance with a

predetermined DTD (document type definition)." (Chakraborty, paragraph 0008).

With regards to claim 3, Altamura et al teaches a method wherein *mapping the properties further comprises mapping a type attribute that corresponds to the mini-document* (P9-3: whereas, each type of mini-document is identified by a an ID number, such as 'id0).

With regards to claim 6, which depends on claim 1, Altamura et al teaches a method wherein:

- *Determining the properties corresponding to an additional mini-document that relates to at least one section of the application document:* (Fig. 3, p6-5: whereas, layout analysis is performed to determine one or more additional mini documents/blocks that have like properties in a document).

- *Mapping the properties of the additional mini-document into at least one of a markup language element, an attribute and a value:* (P9-3: whereas, the properties of the additional mini-document, such as a running-header, is mapped into an element (labeled 'ID'), and assigned an ID value such as 'id0' for one type of mini-document, and 'id4' for another type of mini document).

- *Storing the properties of the mini-document in the markup language document:* (P8-1 and P9-3: whereas, the properties are stored in a DTD data file).

With regards to claim 7, which is dependent on claim 1, Altamura et al teaches a method comprising:

- *Determining whether properties associated with all mini-documents of the application document have been stored in the markup language*

document; and processing further mini-documents when the properties

associated with all mini-documents have not been stored in the markup

language document (P7-9: whereas, the application document is

translated into HTML/XML formats by aggregating all textual, graphical,

layout and logical information extracted in the document analysis and

understanding process).

With regards to claim 8, which is dependent on claim 1, Altamura et al

teaches a method wherein *the properties of the mini-document stored in the*

markup language document (in claim 1, and is rejected under the same

rationale), *are understood by an application that understands the markup*

language when the mini-document is not native to the application (P7-10, Fig. 5:

whereas, xml documents can be sent to a client browser that does not have the

mini-document native to the application, through the help of a validating parser

using an agreed schema of information exchange (DTD) + XML)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 2, 10-13, and 16-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Altamura et al (IJDAR, published: November 7, 2000, pages

6-12) and Chakraborty (US Application: US 2004/0194035 A1, filed: Mar. 31,

2003) in further view of Klink et al (DFKI, published, September 25, 2000, pages

1a, 3, 4, and 11).

With regards to claim 2, which depends on claim 1, Altamura et al teaches a

method *further comprising determining whether the mini-document is one of a*

header (P9-3, whereas, a mini-document is recognized to be a header (labeled

as 'running-header')). However, Altamura et al does not expressly teach

determining whether the mini-document is one of a footer.

Klink et al teaches *determining the mini-document is one of a footer* (Section

4.1: whereas, each block/mini-document in the document are determined,

including footers).

Furthermore, Altamura et al and Klink et al are analogous art since they are

from the same problem solving area: document analysis and document data in

XML.

It would have been obvious to one of the ordinary skill in the art at the time of

the invention to have modified Altamura et al's set of mini-documents to further

include recognizing a footer as a mini-document as well. The combination of

Altamura et al, Chakraborty, and Klink et al would have allowed better

"recognition of document structure" (Klink et al, Section 4) in Altamura et al's

system.

With regards to claim 10, Altamura et al teaches a computer readable medium

comprising:

- *Determining properties relating to a mini-document* (similar to claim 1, and

  is rejected under the same rationale) *used within a word processing*

document (P9-4: whereas, the image document is word processed since

OCR technology is used to extract words from the image, and thus

represents a word processing document as well).

- *Determining whether the mini-document is one of a header* (P9-3,

  whereas, a mini-document is recognized to be a header (labeled as

  'running-header').

- *Writing the properties into at least one of a markup language element, an*

  attribute, and a value, similarly in claim 1, and is rejected under the same

  rationale.

- *Storing the properties in the markup language document such that the*

  headers of the word-processing document are substantially maintained

  when the markup language document is parsed by an application (P8-1

  and P9-3: whereas, the properties are stored in a DTD data file).

However, Altamura et al does not expressly teach *determining whether the*

mini-document is one of a footer, and the properties stored in a markup language

file such that the *footers* of the word-processing document are substantially

maintained when the markup language document is parsed by an application.

Klink et al similarly teaches *determining whether the mini-document is one of*

a footer, in claim 2, and is rejected under the same rationale. Furthermore, Klink

et al teaches storing properties of mini-document data in a markup language file

(Section 7: whereas, document representation data can be stored in HTML/XML

format)

It would have been obvious to one of the ordinary skill in the art at the time of

the invention to have modified Altamura et al's ability to determine whether a

mini-document is a header, to also further include the ability to determine

whether a mini-document is a footer for storage in a markup language document

as taught by Klink et al. The combination of Altamura et al, Chakraborty, and

Klink et al would have allowed Altamura et al's system to have ensured that the

footer properties in a markup language document would have been substantially

maintained when a markup language document was stored by an application.

With regards to claim 12, which depends on claim 10, Altamura et al teaches

a computer readable medium for performing a method similar to claim 8, and is

rejected under the same rationale.

With regards to claim 13, which depends on claim 10, Altamura et al teaches

a computer readable medium for performing a method similar to claim 3, and is

rejected under the same rationale.

With regards to claim 16, which depends on claim 13, Altamura et al teaches

a computer readable medium comprises:

- *Determining properties corresponding to an additional mini-document that*

  relates to at least one section (similarly in claim 6, and is rejected under

  the same rationale), *of a word processing document* (in claim 10, and is

  rejected under the same rationale).

- *Mapping the properties of the additional mini-document into at least one of*

  a markup language element, an attribute, and a value; and storing the

  properties of the additional mini-document in the markup language

document. (as similarly taught in claim 6, and is rejected under the same

rationale).

With regards to claim 17, which depends on claim 13, Altamura et al teaches

a computer readable medium for performing a method similar to claim 7, and is

rejected under the same rationale.

With regards to claim 18, Altamura et al teaches a system comprising:

- *Determining properties relating to a mini-document included in at least one*

  section of an application document. (similarly in claim 1, and is rejected

  under the same rationale).

- *Determine whether the mini-document is one of a header* (P9-3, whereas,

  a mini-document is recognized to be a header (labeled as 'running-

  header').

- *Map the properties into at least one of a markup language element, an*

  attribute, and a value: (similarly, in claim 1, and is rejected under the same

  rationale).

- *Store the properties in the markup language document* (similarly in claim

  1, and is rejected under the same rationale), *and a validation engine*

  configured to validate the markup language document (P7-10: whereas, a

  parser is used for validating the XML document).

However, Altamura et al does not expressly teach *determining whether the*

mini-document is one of a footer, and the properties stored in a markup language

file such that the *footers* of the word-processing document are substantially

maintained when the markup language document is parsed by an application.

Klink et al similarly teaches *determining whether the mini-document is one of a footer*, in claim 2, and is rejected under the same rationale. Furthermore, Klink et al teaches storing properties of mini-document data in a markup language file (Section 7: whereas, document representation data can be stored in HTML/XML format)

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's ability to determine whether a mini-document is a header, to also further include the ability to determine whether a mini-document is a footer for storage in a markup language document as taught by Klink et al. The combination of Altamura et al, Chakraborty, and Klink et al would have allowed Altamura et al's system to have ensured that the footer properties in a markup language document would have been substantially maintained when a markup language document was stored by an application.

With regards to claim 19, which depends on claim 18, Altamura et al teaches a system performing a method similar to claim 6, and is rejected under the same rationale.

With regards to claim 20, which depends on claim 18, Altamura et al teaches a system performing a method similar to claim 7, and is rejected under the same rationale.

With regards to claim 21, which depends on claim 18, Altamura et al teaches a system wherein *the properties of the mini-document stored in the markup language document are understood by an additional application that understands the markup language when the mini-document is not native to the additional*

application (P7-10, Fig. 5: whereas, xml documents can be sent to a additional

application (client browser) that does not have the mini-document native to the

additional application, through the help of a validating parser using an agreed

schema of information exchange (DTD) + XML)).

10.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Altamura et al (IJDAR, published: November 7, 2000, pages 6-12) and

Chakraborty (US Application: US 2004/0194035 A1, filed: Mar. 31, 2003) in

further view of Eisenberg (XML.com, published, June 8, 2001, pages 1a and 1).

With regards to claim 4, which depends on claim 1, Altamura et al teaches a

method for a *mini-document occurring in a specified section of the application*

document (in claim 1, and is rejected under the same rationale), and a *type*

attribute, in claim 3, and is rejected under the same rationale. However, Altamura

et al does not expressly teach the type attribute corresponding to *whether* the

mini-document *occurs on a first page, odd pages, or even pages of the*

application document.

Eisenberg teaches the *attributes* for whether pages *correspond to even, or*

odd number pages of a document (P1-4), as well as a *first page* (P1-2: whereas,

a cover page is a sequence of one page).

It would have been obvious to one of the ordinary skill in the art at the time of

the invention to have modified Altamura et al's type attribute for whether a

document (such as a mini-document) occurs on a first, even, or odd page as

taught by Eisenberg. The combination of Altamura et al, Chakraborty, and

Eisenberg would have allowed Altamura et al's system to have "specified the

order (of pages) when it was the time to generate a sequence of pages"

(Eisenberg, P1-1).

11.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Altamura et al (IJDAR, published: November 7, 2000, pages 6-12) and

Chakraborty (US Application: US 2004/0194035 A1, filed: Mar. 31, 2003) in

further view of Pavlov (US Patent: 6,725,426 B1, published: Apr. 20, 2004, filed:

Mar. 17, 2000).

With regards to claim 9, which is dependent on claim 1, Altamura et al

teaches a method for wherein *the markup language document is manipulated* on

a client station *to substantially reproduce the mini-document of the application*

document not withstanding the presence of an application that generated the

markup language document (Section 6.2, Fig. 5: whereas, the properties stored

in the markup document, are understood by a client web browser to reproduce

the document without using WISDOM++). However Altamura et al does not teach

the markup language document is *manipulated on a server* to reproduce the

mini-document.

Pavlov teaches a markup language document is *manipulated on a server to*

reproduce the mini-document (column 3, lines 59-65: whereas, a system capable

of retrieving XML content is manipulated by a server to reproduce a document for

a particular device).

It would have been obvious to one of the ordinary skill in the art at the time of

the invention to have modified Altamura et al's mini-document reproduction

system to be reproduced on a server system as taught by Pavlov. The

combination of Altamura et al, Chakraborty, and Pavlov would have allowed

Altamura et al's system to have "stored content in XML format instead of word

processing documents" (Pavlov, column 1, lines 34-39).

12.   Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Altamura et al (IJDAR, published: November 7, 2000, pages

6-12), Klink et al (DFKI, published, September 25, 2000, pages 1a, 3, 4, and 11)

and Chakraborty (US Application: US 2004/0194035 A1, filed: Mar. 31, 2003), in

further view of Pavlov (US Patent: 6,725,426 B1, published: Apr. 20, 2004, filed:

Mar. 17, 2000).

With regards to claim 11, which depends on claim 10, Altamura et al a

computer readable medium comprising:

- A *word processing document,* similarly, in claim 10, and is rejected under
  the same rationale.

- *The markup language document is manipulated* on a client *to substantially
  reproduce the mini-document of the word-processing document not
  withstanding the presence of an application that generated the markup
  language document* (Section 6.2, Fig. 5: whereas, the properties stored in
  the markup document, are understood by a client web browser to
  reproduce the document without using WISDOM++). However Altamura et
  al does not teach the markup language document is *manipulated on a
  server to reproduce the mini-document.*

However, Altamura et al does not teach the markup language document is

manipulated on a server to reproduce the mini-document.

Pavlov teaches a markup language document is *manipulated on a server to reproduce the mini-document* (column 3, lines 59-65: whereas, a system capable of retrieving XML content is manipulated by a server to reproduce a document for a particular device).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's mini-document reproduction system to be reproduced on a server system as taught by Pavlov. The combination of Altamura et al, Klink et al, Chakraborty, and Pavlov would have allowed Altamura et al's system to have "stored content in XML format instead of word processing documents" (Pavlov, column 1, lines 34-39).

With regards to claim 22, which depends on claim 18, Altamura et al teaches a system performing a method similar to claim 9, and is rejected under the same rationale.

13.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Altamura et al (IJDAR, published: November 7, 2000, pages 6-12) , Klink et al (DFKI, published, September 25, 2000, pages 1a, 3, 4, and 11) and Chakraborty (US Application: US 2004/0194035 A1, filed: Mar. 31, 2003), in further view of Eisenberg (XML.com, published, June 8, 2001, pages 1a and 1).

With regards to claim 14, which depends on claim 13, Altamura et al teaches a method for a *mini-document occurring in a specified section of the word processing document* (in claim 10, and is rejected under the same rationale), and a *type attribute*, similarly in claim 3, and is rejected under the same rationale. However, Altamura et al does not expressly teach the type attribute

corresponding to *whether* the mini-document *occurs on a first page, odd pages, or even pages of the* word processing document.

Eisenberg teaches *attributes* for whether pages *correspond to even, or odd number* pages of a document (P1-4), as well as a *first page* (P1-2: whereas, a cover page is a sequence of one page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's type attribute for whether a document (such as a mini-document) occurs on a first, even, or odd page as taught by Eisenberg. The combination of Altamura et al, Klink et al, Chakraborty, and Eisenberg would have allowed Altamura et al's system to have "specified the order (of pages) when it was time to generate a sequence of pages" (Eisenberg, P1-1).

Response to Arguments

14.   Applicant's arguments with respect to "an application", and "a validation engine" sufficiently discloses hardware to qualify as statutory subject matter has been considered, but are not persuasive. With respect to "an application", the applicant argues "the application is configured to ... store ... properties in the markup language element". However, the Examiner respectfully points out that an application, in computer science terms, is an application is "a subset of computer software" (as defined by www.wikipedia.org), and the applicant is requiring the behavior/operation of the computer software to include storing properties in the markup language element, as opposed to requiring the behavior/operation of hardware to include storing properties. With respect to "the

validation engine", the applicant argues "the validation engine is configured to validate the markup language element". However, the Examiner respectfully points out that an "engine" in computer science terms includes the code or software as the basis for building a specific application, such as defined by www.webopedia.com, "the code or software as the basis for building a game", in addition, such as known in the art, and defined by http://techdictionary.com, an engine, such as a search engine is defined by "a program on the internet that allows users to search for files and information". Thus, neither the application , or the validation engine serves as a sufficient basis for including hardware.

15.   Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

16.   Applicant's arguments with respect to amended claims 10 and 18, which include substantially the same limitations as amended claim 1, as being allowable have been considered, but are considered non-persuasive since amended claim 1 has been shown to be rejected (as explained above).

17.   Applicant's arguments with respect to claims 2-4, 6-9, 11-14, 16, 17, and 19-22, for being allowable because the base claims on which they rely are allowable, have been considered, but are considered non-persuavie since the amended independent base claims have been shown to be rejected (as explained above).

Conclusion

18.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.
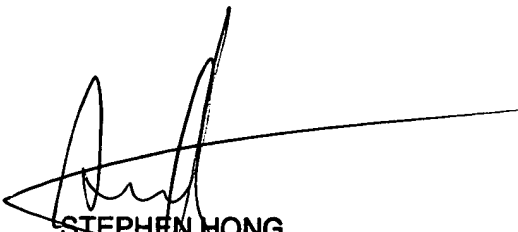
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

Wilson Tsui
Patent Examiner
Art Unit: 2178
August 17, 2006

STEPHEN HONG
SUPERVISORY PATENT EXAMINER